



PATENT CASE: IN01174

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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 In re Application of:
 Zhu *et al.*

For:
**DIARYL PEPTIDES AS NS3-SERINE
 PROTEASE INHIBITORS OF HEPATITIS
 C VIRUS**

Serial No.: 10/013,071

Filing Date: 12/10/2001
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: Examiner: R. B. Mondesi
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: Date: 03/03/2004
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: Art Unit: 1653
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Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

RESPONSE

Sir:

This communication is in response to the Official Action dated January 26, 2004, on the subject patent application.

Claims 1-94 are pending in the case. The Examiner restricted the invention into three groups:

Group I: Claims 1-23, 28-54, 59-87 and 92-94 drawn to a pharmaceutical composition comprising the inventive compounds;

Group II: Claims 24-25, 55-56 and 88-89 drawn to a method of treating diseases; and

Group III: Claims 26-27, 57-58 and 90-91 drawn to a method of manufacturing a medicament.

In Group I, the Examiner additionally required the election of a single disclosed moiety in positions X, Y, R', R2', P^{1a}, P^{1b}, Ar¹, Ar², P³ and P⁴, as well as a single atom or molecule for positions A, E, G, J, L, M and Q, that is searchable for prosecution on the merits. The Examiner has also stated that in the event product claims are found allowable, process claims relating to the allowed product(s) will be rejoined as a matter of right.

Applicant believes that all claims 1-94 form part of one and the same invention. Applicant believes that when there is a linking claim (claim 1 here)

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encompassing the scope of all the processes, uses, composition and compounds, it is inappropriate to restrict the invention into these various inventions. Applicant also believes that due to such commonality, a complete examination of claims 1-47 as filed would not cause undue burden. Applicant further believes that the same art search will most probably apply to the alleged separate inventions, and respectfully submits that the restriction is improper.

Under the statute "two or more independent and distinct inventions.... in one application may.... be restricted to one of the inventions." Inventions are "independent" if "there is no disclosed relationship between two or more subjects disclosed" (MPEP 802.01). The term "distinct" means that "two or more subjects as disclosed are related.... but are capable of separate manufacture, use or sale as claimed, and are patentable over each other" (MPEP 802.01). However, even when patentably distinct inventions, restriction is not required unless one of the following reasons appear (MPEP 808.02):

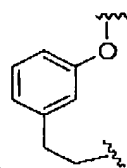
1. Separate classification
2. Separate status in the art; or
3. Different field of search.

In the present application, Applicant believes that the Examiner has not established a clear reason to establish the existence of any of the above 3 groups. Reconsideration and withdrawal of the restriction requirement are, therefore, respectfully requested.

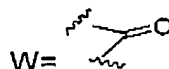
Furthermore, in order to comply with the Examiner's requirement, Applicant is electing, with traverse, the invention cited as Invention Group No. 1 by the Examiner. Additionally, in order to comply with the requirement that moieties/atoms be elected for examination purposes, Applicant is electing the following moieties/atoms based on generic Formula I in this case, and therefore, the following moieties/atoms are elected in the claims of Group I:

X= alkyl, e.g., 

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Y = aryl ether, e.g.,



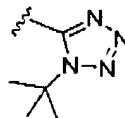
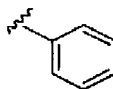
W =

Z = NH

U = CH

R' = H

R'' = H

P^{1a} = C1-C10 straight chain alkyl, e.g., P^{1b} = HP^{1'} = HAr¹ = heteroaryl, e.g.,Ar² = aryl, e.g.,P³ = alkyl, e.g.,P⁴ = HG = CH₂

E = CH

L = CH₂

A = O

Q is absent and M is absent and A is directly linked to X.
J is absent and L is directly linked to Nitrogen

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If the Examiner has questions, the Examiner is invited to contact the undersigned.

Respectfully submitted,



Dr. Palaiyur S. Kalyanaram
Registration No. 34,634
Attorney for Applicants
Tel: 908-298-5068
Fax: 908-298-5388